

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF APPEALS

In re Application of

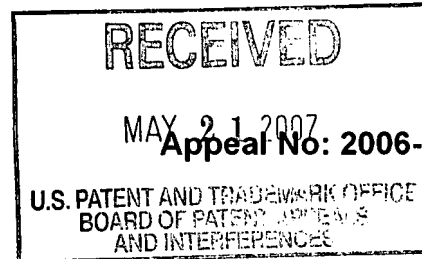
Robert SKVORECZ

Reissue of U. S. Patent: 5,996,948

SERIAL NO. : 09/772,278

FILED : March 15, 2001

FOR : WIRE CHAFING STAND



REQUEST FOR REHEARING OF BOARD DECISION UNDER 37 CFR 41. 2

BOARD OF PATENT APPEALS AND INTERFERENCES
UNITED STATES PATENT AND TRADEMARK OFFICE
P. O. Box 1450
Alexandria, VA 22313-1450

SIR:

All necessary fees in connection with this request for a rehearing of the appeal decision from the Board Of Appeals should be deducted from Deposit Account No. 503814.

i) **Real Party In Interest:**

Robert Skvorecz, as appellant, is currently the real party in interest.

ii) **Related Appeals and Interferences:**

There is no related appeal or interference proceeding.

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iii) **Status of Claims:**

Claims 1-7 are pending in this reissue patent application. Claims 1-5 and 7 are under appeal and claim 6 stands allowed and is not, as such, involved in the appeal. Pursuant to the decision of the Board dated March 28, 2006, the rejection of claims 1 and 2 under 35 USC 102(b) was affirmed, the rejection of the claims 1-5 and 7 under USC 251 was reversed and the rejection of claim 5 under 35 USC 102(b) was reversed. The Board also entered a new ground of rejection of claims 1-5 and 7 under 37 USC 41.0 (b) including a rejection of claim 5 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention and a rejection of claims 1-5 and 7 under 35 USC 112, first paragraph, as failing to comply with the written description requirement.

iv) **Request For Oral Rehearing And Opportunity To Present A Model of Prior Art To Rebut Inherency Allegation:**

It is admitted that it is unusual and not the normal practice of the Board to grant an oral hearing after a decision. However, for Appellant to make a good effort under 37CFR 41.2, Appellant requests an oral hearing and the opportunity to present to the Board a model of the prior art structure to substantiate that the prior art reference Buff '062 does not possess the characteristics of the claimed subject matter and to show that the functionality limitations of the claimed subject matter is not inherent in the product of Buff '062. The Board, on page 22 of its Decision, states that "the (alleged) prima facie case of anticipation (of claims 1 and 2 under 35

USC 102(b) may be rebutted by evidence (**emphasis added**) showing that the prior art products do not necessarily possess the characteristics of the claimed product, In re Best 562 F 2d at 1255". Appellant believes this warrants the presentation of a model of the prior art Buff '062 to prove lack of inherency. The model that Appellant desires to present to the Board at the oral hearing, to refute the inherency allegation, is a duplicate reproduction of the product of Buff '062.

v) **Points Misapprehended or Overlooked in Board's Decision**

I. The principle issue in the rejection of claims 1 and 2 under 35 USC 102(b) is whether the "offsets" in Buff cause a lateral displacement to occur in **each** wire leg as required in claim 1 relative to the rim. Claim 1 is patentable because there must be at least two wire legs in the stand and that the plurality of offsets must cause a lateral displacement to occur in each wire leg (**not in selected wire legs**) relative to the rim. Claim 1 does not permit a displacement to occur in less than each wire leg in the stand relative to the rim. Moreover, such an interpretation of Claim 1 would be contrary to the definition of "offset" in Appellant's specification as set forth in column 2 lines 7-12, which states that the offsets "laterally displaces each (wire) leg relative to the point of attachment of the wire leg with the upper rim of the stand so that the wire legs of one wire stand (Note: not selected wire legs in the stand) can substantially nest within another wire stand without significant wedging." In fact, claim 1 explicitly reads "laterally displacing each wire leg (not selected wire legs) relative to said first rim" and specifically requires the plurality of offsets to be **located in said upright sections of said wire**

legs (emphasis added). Accordingly, if there are more than two wire legs in the stand such as in Buff, the lateral displacement must occur in each of the more than two wire legs and not in less than each, i. e., cannot occur only in a selected limited number of wire legs. The Board has overlooked or has misapprehended this critical limitation in Claim 1.

Buff uses three wire legs represented by a single lateral wire leg 48 and two longitudinal wire legs 49 to form a support frame 20 with each of the three wire legs having upright sections 50. However, only the two longitudinal wire legs 49 include the alleged "offsets 52" in the upright sections 50. The alleged "offsets 52" do not exist in the upright sections 50 of the lateral leg 48. Note that Buff deliberately uses the same reference number 50 to define the upright sections 50 of the lateral leg 48 as is used for the upright sections 50 of the two longitudinal legs 49, all of which constitute the support stand 20. The existence of the lateral leg 48 is essential to the support frame 20 in Buff and the omission of offsets in its upright sections 50 cannot be ignored or disregarded. Moreover, the lateral leg 48 without offsets in Buff is not unintentional and contradicts the express requirement in claim 1 of offsets located in said upright sections of said wire legs (said upright sections refers back to the expression in claim 1 of at least two and not to selected wire legs) and that a lateral displacement must occur in each wire leg in the stand (not in less than each) relative to the rim. It also contradicts the explicit definition of "offsets" in Appellant's specification in column 2 lines 7-12, in which each wire leg in the stand must have an offset to laterally displace each leg **so that the wire legs of one wire**

stand (not selected wire legs in the stand) can substantially nest within another wire stand without significant wedging. This definition is consistent with the wording used in claim 1 and does not permit a broader definition inconsistent with its plain meaning. Applying an explicit definition for a term “offset” used in Appellant’s specification consistent with its claims is clearly mandated in the MPEP 2111.01 IV; see also *Toro Co. v White Consolidation Industries*, 53 USPQ2d 1065, 199 F. 3d 1295 (Fed. Cir.1999).

II. The alleged “offsets” 52 in Buff ‘062 will not cause a lateral displacement to occur in each wire leg as required in claim 1 relative to the rim for the following reasons:

(a) No offsets exist in the upright sections 50 of the lateral wire leg 48 of Buff ‘062 as explained above; and/or

(b) The alleged “offsets” 52 in Buff ‘062 are passive elements and cannot cause a lateral displacement to occur even in the longitudinal wire legs 49 in response to an attempt to nest a multiple number of stands together because the stand in Buff is not designed to do so based upon the addition of the lateral leg 48 which does not have any offsets and the fact that the alleged offsets 52 in Buff are not properly located along the wire legs 49 to perform the function of a lateral displacement. In Appellants specification the “offsets” facilitate the nesting of a multiplicity of stands into one another without significant wedging for reasons as taught in column 4, second paragraph, and as set forth in claim 1 by performing a

lateral displacement in each wire leg relative to the upper rim at the point of attachment of the leg and upper rim (see column 2 lines 9-10). For an offset to cause a lateral displacement in accordance Claim 1 and in accordance with its explicit definition in column 2 lines 7-12, each "offset" must be located at a position in the structure to enable it to respond to a wedging force in an attempt to nest multiple stands into one another without interference from other structural components in the stand such as the lateral leg in Buff. Appellant's specification requires each offset to be located at the point of interconnection of the wire leg and upper rim, see column 2 lines 27-29, or at a predetermined location along the wire leg below the upper rim (see column 4 line 16). The reference elements 52 in Buff, which are alleged to represent offsets, are designed as passive supporting elements (function solely to support a roasting pan) and are not designed to be displaced laterally, or in any other direction including a longitudinal direction, because they are located in the handle portion 38 of the wire leg 49 which is not located at the point of interconnection of the wire leg and upper rim or below the rim but is located **above the rim 40** and because of the interference of the lateral leg 48 which itself cannot move "*laterally*" independent of how the word "laterally" is defined. Because the alleged offsets 52 in Buff are located above the rim 40 and because of the existence of the lateral leg 48 which interferes and prevents any alleged lateral movement of the wire legs 49, the alleged offsets 52 in Buff will not and can not perform the function of "laterally displacing each wire leg relative to said first rim" as called for in claim 1. Appellant intends to substantiate this using the model of Buff '062 if

permitted to do so. Thus, the product in Buff '062 does not possess the characteristics of the claimed product.

III. Instead of relying upon the explicit definition for the term “offset” as defined in column 2 lines 7-12 of the Appellant’s patent specification, the Board appears to have elected to use a substitute definition which in effect gives the term a new meaning or eliminates the words “laterally displacing” from Claim 1 contrary to MPEP 2111.01 IV and *Toro Co. v. White Consolidation Industries* 53 USPQ2d 1065. The Board, on page 20 of the Brief (Heading B) lines 12-14, states that “Appellant’s specification never limits the term “lateral” to describing the short axis side. Rather, Appellant’s specification only uses “lateral” in the broader sense of sideways from either the long axis or short axis. ” To the contrary, Appellant’s specification uses the term “laterally displacing” in claim 1 and in the specification solely as a functional expression for “offset” and only in the context of the definition of “offset” which the specification explicitly defines. Nowhere is the word “sideways” used in Appellant’s specification and the specification does not use either of the terms “long axis” or “short axis”. In fact, in claim 1 the rim of the stand may have any geometry including a square geometry and, as such, “long axis” and “short axis” would be confusing and out of context. Since the expression “laterally displacing” in claim 1 is an integral part of the definition of “offset” in column 2 lines 6-12 of Appellant’s specification, it clearly cannot be construed by means of an independent hypothetical definition to mean a sideways displacement in either a lateral direction or a longitudinal direction because such an interpretation clearly gives the term

"offset" too broad a meaning and has the effect of negating or eliminating the adjective "laterally" in its entirety from claim 1 and from the context in which it is used in the explicit definition of "offset" in Appellant's specification. In addition, using a revised interpretation in place of an express definition which changes its plain meaning is precluded in the MPEP 2111.01 IV and *Toro Co. v. White Consolidation Industries* 53 USPQ2d 1065.

vi) **New Arguments in Response to the New Grounds Of Rejection**

1. The new rejection of Claim 5 under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention is respectfully traversed. This rejection is based upon the wording in Claim 5 -- "the separation of the upright sections into segments" --. Admittedly, there is no express definition in Appellant's specification for the terms "separation" and "segments" as used in claim 5. However, the wording of claim 5 was not amended from the wording of claim 5 as originally filed and was never objected to or rejected as being indefinite during the prosecution of the application. Accordingly, Appellant should be accorded the standard of interpretation for words in a claim as set forth in the MPEP 2111.01, paragraph III, and as set forth in *ACTV, Inc. v. The Walt Disney Company* 68 USPQ 2d 1516, 346 F. 3d 1082 (Fed. Cir. 2003) wherein it states that if there is no express definition given for a term in the specification, as in the present case, the term should be given "its broadest reasonable interpretation consistent with the intrinsic record and take

on the ordinary and customary meaning attributed to it by those of ordinary skill in the art” at the time of the invention.

If the above standard of interpretation is applied to the recitation of claim 5, then in the context of the preceding words in claim 5 which read --“wherein said plurality of offsets are welded to said wire legs at”-- it becomes clear that the operation of welding forms welded joints in the wire legs at the intersection of each offset and each wire leg at a location along the wire legs which, in accordance to its plain meaning, divide or separate the upright sections of the wire legs into segments. In all of the embodiments of the invention the plurality of offsets are formed in the upright sections of the wire legs. It is then apparent from the plain meaning of the words following “wherein said plurality of offsets are welded to said wire legs at” that the limitation “the separation of the upright sections into segments” broadly defines the location of the offsets along the wire legs and nothing more. In this context pursuant to the MPEP 2111.01 paragraph III, the recitation of the words -- “the separation of the upright sections into segments” -- are believed sufficiently clear and definite to satisfy 35 USC 112, second paragraph.

2. The new rejection of Claims 1-5 and 7 under 35 USC 112, first paragraph, for failing to comply with the written description requirement is respectfully traversed. This rejection is based upon the allegation that Claim 1 which recites “a plurality of offsets located in said first rim for laterally displacing each wire leg relative to said first rim” has no support in Appellants’ specification as filed.

To the contrary, Figures 12 and 13 and the text in column 5 lines 16-19 (just above the claims) directly support this recitation word for word.

The Board alleges that the offsets shown in Figures 12 and 13 “do not laterally displace the wire leg relative to the rim”. This allegation of the Board is presented in an absolute sense but without explanation or support. Apparently, the Board is alleging that Figures 12 and 13 represent an inoperable embodiment of the claimed structure because of the direction of the offsets as shown in Figures 12 and 13. If so, the rejection of the claims under 35 USC 112 based upon an allegation of inoperability is misplaced. To the contrary, the claims, in respect to this embodiment, do not recite any given direction for the offsets but only that the offsets be located in the rim. This language conforms exactly to what is shown in the embodiment of Figures 12 and 13 and to the description in the specification. Moreover, the description in the specification does not even mention a direction for the offsets. Even if the Board considers the embodiment of Figures 12 and 13 to be inoperative, MPEP 2164.8(b) determines the standard for enablement under 35 USC 112, first paragraph, based upon an allegation of inoperability which the Board has overlooked or misapprehended. MPEP 2164.8(b) states that “The presence of an inoperative embodiment within the scope of a claim does not necessarily render a claim non-enabled. The standard is whether a skilled person could determine which embodiments that were conceived, but not yet made, would be inoperative or operative with expenditure of no more effort than is normally required in the art. *Atlas Powder Co. v. E. I. du Pont de Nemours & Co.* 224 USPQ 409, 750 F. 2d

1569 (Fed. Cir. 1984). Figs. 12 and 13 represent a prophetic example of the embodiment where the offset is to be located in the rim. It does not make the disclosure non-enabling. It may be inferior to an alternative embodiment with the offsets facing the opposite direction, but it is not non-enabling.

Admittedly, during the prosecution of the application, Appellant unsuccessfully tried to amend the drawings of Figures 12 and 13 to modify the directional orientation of the offsets (so that they face the opposite direction). A much better performance is indeed achieved with the offsets in the opposite direction. However, the Board should not have drawn a conclusion based upon the unsuccessful amendment to the drawings, which does not constitute an admission by Appellant of the inoperability of Figs. 12 and 13 in their present form. Furthermore, the Board has not indicated that this feature is critical to the invention or should be considered to be critical. Neither has the Board addressed the issue of "inoperability". Accordingly, the allegation of the Board that claims 1-5 and 7 fail to comply with the written description of 35 USC 112 is without support and should be withdrawn, since the embodiment is clearly enabling in accordance with MPEP 2164.08(b) and is described consistent with the specification.

Lastly, the statement of the Board that Claim 5 recites a further limitation of the offsets located in the rim is clearly in error in that the language of Claim 5 does not require or remotely suggest that the offsets need to be located in

the rim. In fact, in the embodiment of figure 11 the weld 33 locates the offsets at the point of intersection with the rim but not in the rim.

Accordingly, the rejection of claims 1-5 and 7 under 35 USC 112 should be withdrawn.

CONCLUSION

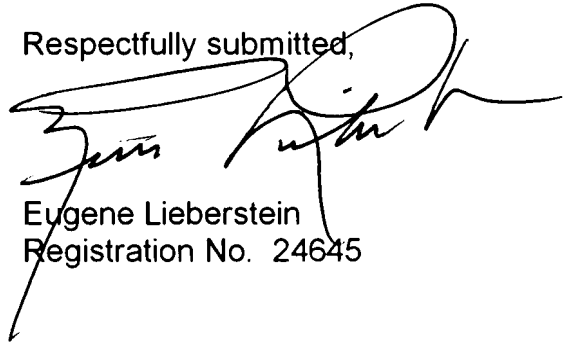
As explained above, the Board has overlooked or has misapprehended a critical limitation in Claim 1 and, for this reason alone, should reconsider and reverse the rejection of claims 1 and 2 under 35 USC 102(b).

Alternatively, Appellant has presented evidence which rebuts the *prima facie* case of anticipation and clearly supports the conclusion that the prior art product Buff does not inherently possess the characteristics of the claimed product. In this regard, Appellant offers to present a model of Buff as further evidence to substantiate that Buff does not inherently possess the characteristics of the claimed product.

The new rejections of claims 1-5 and 7 under 35 USC 112 should be withdrawn in that Appellant has demonstrated that the claims are clearly enabled within the context of 35 USC 112 first paragraph, and that the rejection of claim 5 under 35 USC 112 is in error.

For all of the above reasons, Appellant respectfully solicits the Board of Patent Appeals to reverse the final rejection of claims 1 and 2 and to withdraw the new rejections of claims 1-5 and 7.

Respectfully submitted,



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Dated: May 18, 2007

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